

REMARKS

In accordance with the foregoing, the specification and claims 1-17 have been amended. Claims 1-17 are pending and under consideration.

REJECTION UNDER 35 U.S.C. § 101:

On page 2 of the Office Action, the claims are rejected under 35 U.S.C. § 101 because the method claims 14 and 17 do not include computer performing steps. In view of the amendments made to claims 14 and 17, it is respectfully requested that the rejection to the claims be withdrawn.

REJECTION UNDER 35 U.S.C. § 112:

On page 2 of the Office Action, claims 1-16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for comprising "combination type," which it is found unclear. Independent claims 1, 10, 14, 15, and 16 have been amended to further define the combination type as "a type of a combination of a business entity providing a service to the network apparatuses that bear the costs related to the network apparatuses, each network apparatus receiving the service from the business entity specified by said combination type," to further clarify the claimed features recited in the claims. Accordingly, it is respectfully requested that the rejection to the claims be withdrawn.

REJECTION UNDER 35 U.S.C. § 102:

On page 3 of the Office Action, claims 10-12 and 16 rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,333,979 to Bondi et al. ("Bondi").

Bondi generally describes an apparatus and method to route calls to communication processing centers (CPC) based on an optical destination plan. See column 4, line 49, to column 5, line 67. Calls are allocated on a basis of area codes, regions, or other predetermined categories to a particular CPC. These categories do not correspond or teach or suggest the combination type of the present invention. In particular, the categories of Bondi fail to teach or suggest, "a type of a combination of a business entity providing a service to the network apparatuses that bear the costs related to the network apparatuses, each network apparatus receiving the service from the business entity specified by said combination type," as recited in independent claims 10 and 16.

In view of the foregoing, it is respectfully requested that independent claims 10 and 16 and

related dependent claims be allowed.

REJECTION UNDER 35 U.S.C. § 103:

On page 4 of the Office Action, claim 13 is rejected under 35 U.S.C. § 103(a) as being obvious in view of Bondi. This rejection is traversed and reconsideration is requested.

Dependent claim 13 depends from independent claim 10. Accordingly, Bondi must teach or suggest all the claimed features of independent claim 10. The arguments presented above supporting the patentability of independent claim 10 in view of Bondi are incorporated herein.

According to the Office Action, without providing any basis from a reference, it is conclusively asserted that "it would have been obvious to one of ordinary skill in the art to include a removable storage medium placed in the terminal device of Bondi because this would provide convenience for the user who would like to store information in a portable device." However, the MPEP as well as recent case law further supports this requirement of any reliance of Official Notice be specific and detailed as to what is being relied upon and how.

While "official notice" may be relied upon, as noted in MPEP §2144.03, these circumstances should be rare when an application is under final rejection or action under 37 CFR §1.113. Official Notice unsupported by documentary evidence should be only be taken by the Examiner where the facts asserted to be well known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known and only when such facts are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. **Further, the applicant should be presented with the explicit basis on which the Examiner regards the matter as subject to official notice sufficient to allow the applicant a proper opportunity to challenge that assertion.**

It is improper to merely deem something obvious without any teaching/suggestion, or the taking of Official Notice. If the U.S. Patent and Trademark Office wishes to take Official Notice that the proposed structural and functional modification is notoriously well known, it is respectfully requested that supporting evidence be provided. **The Federal Circuit has cautioned that an Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.** In re Rouffet, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

Thus, both the MPEP and recent case law specifically detail that whenever Official Notice is taken, which should be on very rare occasions, the Office Action must provide the explicit support or evidence for the reliance on Official Notice "to allow the applicant a proper opportunity to challenge that assertion."

The outstanding Office Action has provided no explicit support of what the purported well-known features encompass or how the determination of those features as being well known has been determined. Rather, the Office Action only cites Bondi, without pointing how the claimed features have been determined as being well known.

It is respectfully requested that independent claim 10 and related dependent claim 13 be allowed.

Further, on page 4 of the Office Action, claims 1-9, 14-15, and 17 are rejected under 35 U.S.C. § 103(a) as being obvious in view of Bondi and U.S. Patent No. 6,606,653 to Farris ("Farris"). This rejection is traversed and reconsideration is requested.

Independent claims 1 and 14-15 recite, "wherein said combination type is a type of a combination of a business entity providing a service to the network apparatuses that bear the costs related to the network apparatuses, each network apparatus receiving the service from a business entity specified by said combination type." The arguments presented above supporting the patentability of such recitation in view of Bondi are incorporated herein.

Farris generally describes voice calls between two end location gateway servers of a data internetwork being diverted, during periods of unacceptable network conditions, through the public switched telephone network (PSTN). See abstract. A plurality of such diverted calls may be multiplexed into a single ISDN or T1 channel, thereby permitting a sharing of the more expensive cost of PSTN routing. Incoming calls are appropriately formatted for digital transmission, including compression when applicable, by the gateway servers and multiplexed for transmission either through the data network or back through an ISDN channel or the like through the PSTN. However, similarly to Bondi, Farris is silent as to teaching or suggesting, "said combination type is a type of a combination of a business entity providing a service to the network apparatuses that bear the costs related to the network apparatuses, each network apparatus receiving the service from the business entity specified by said combination type," as recited in independent claims 1 and 14-15. A combination of the cited references would fail to provide the recitations of the combination type of the present invention.

Furthermore, Bondi and Farris fail to teach or suggest, "in a case that a service capable of being utilized by said network apparatus is added, managing the sharing of the cost of said distributed network apparatus by the business entity providing the added service and a business entity providing an existing service," as recited in independent claim 17. In particular, the Office Action merely indicates, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the managing unit of Bondi to include managing the sharing

costs related to each terminal device for optimizing the costs of the service.” However, it is improper to merely indicate that a feature is obvious or that it would be obvious to combine the cited reference without showing where in the reference is there a motivation for such combination. There must be supporting rationale and discussion laying out the case for such a conclusion.

Nothing in either reference suggests or supports the purported combination of the references set forth in the Office Action. It is submitted that the reason why no such showing was made is because the prior art of record individually or combined, fail to teach, suggest, or otherwise provide the motivation needed to make such a modification. “To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness.” Ex Parte Clapp, 227 USPQ 972, 973 (B.P.A.I. 1985).

It is respectfully requested that independent claims 1, 14-15 and 17 and related dependent claims be allowed.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

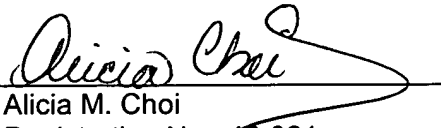
Serial No. 09/811,549

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 01/12/2004

By: 
Alicia M. Choi
Registration No. 46,621

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501